

**REMARKS**

Applicant has carefully studied the nonfinal Examiner's Action mailed June 7, 2005 and all references cited therein. These explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

***Claim Rejections - 35 U.S.C. § 103***

Applicant respectfully acknowledges the quotation of 35 U.S.C. §103.

Claims 1-36 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent Application 2004/0019524 to Marshall in of U.S. Patent No. 6,188,398 to Collins-Rector.

To establish *a prima facie* case of obviousness there must be (1) some suggestion or motivation to combine the references, (2) a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations.<sup>1</sup> Moreover, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.<sup>2</sup> The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>3</sup>

Accordingly, Applicant respectfully presents the following remarks with regard to the cited prior art:

**U.S. Patent Application Publication 2004/0,019,524 to Marshall**

Applicant agrees with, and appreciates, the Examiner's finding that Marshall does not allow a user to access information regarding a product from the content of the video feature. Applicant also notes that Marshall lacks several other elements of Applicants invention. For

<sup>1</sup> MPEP §2142.

<sup>2</sup> *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

<sup>3</sup> MPEP §2143.01; see also *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)( The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.)

example, Marshall does not capture a frame of the video content showing the product nor is a menu interface created with the frame. Marshall employs the use of static thumbnail, or reduced image, to organize products in a separate track. Once the scene is selected a new menu interface is generated independent of the thumbnail image. The still image of the scene is shown and a separate menu interface is placed elsewhere on the screen.

U.S. Patent No. 6,188,398 to Collins-Rector et al.

The '398 patent teaches a method for enabling an interactive video synchronized with advertising material which is HTML based. The system of the '398 patent uses at least 3 separate frames which separately display (a) the video feature, (b) synchronized advertising material, and (c) an advertising tool bar [Col. 4, lines 5-10].

The '398 patent teaches a video feature which is played in a first frame during which a "time ad launch" causes an ad to be shown in a second frame. The ads displayed in the second frame are triggered by either a time setting or cued to the appearance of the product in the feature. Every time an ad is shown in the second frame, a thumbnail image connected to that ad is placed in a visible stack in a third frame. Accordingly, it is the second and third frames which are interactive, and not the first frame showing the video content.

Of notable distinction, the '398 patent describes a system which relies on web pages, specifically HTML (hyper text markup language) pages, to display the video content as well as advertising media. [Col. 4, lines 5-10]. Claim 1 of the instant application claims a system of "presenting purchasing information within a DVD having video content." The preamble is expounded upon by the limitation "capturing at least one frame of the video content." Since the preamble establishes the video content is contained on the DVD this limitation, read in conjunction with the preamble, distinguishes over the '398 patent which requires an Internet connection to function.

Some of the differences between Applicant's claimed invention and the invention of the '398 are displayed in Exhibit A, attached hereto, which consists of claim charts comparing Applicant's invention to the prior art. The specification of the '398 also states that "banner ads" are synchronized to the video content as it plays (first frame) and the relevant products or services are displayed in the banner ad (second frame) as the video content is played. The advertising material is not integral with the video content and is visible whether or not the user

chooses to view information regarding the goods services. [Col. 2, lines 42-46]. Moreover, the '398 patent describes playing advertisements in Frame 2 "at predetermined times while watching [the] video." [Col. 1, lines 44-46]. The method of the instant application lets the user determine when purchasing information is, or is not, displayed.

Exhibit B, attached hereto demonstrates one way the instant application differs from the '398 patent. Figure 1 of Exhibit B shows how the product sought to be sold is identified within the video content. The entire feature comprises linked motion menus that time-out at the end of respective clips and jump to next clip in sequence. The products sought to be sold form selectable buttons over a motion menu. Unless selected, the motion menu will progress to the next clip in the feature presentation.

In contrast, Figure 2 of Exhibit B shows how the method of the '398 patent utilizes multiple frames. The banner ad (Frame 2) is displayed at predetermined times, rather than be selected by the user. Items are then saved in a "stack" at the bottom of the screen in an Ad Toolbar (Frame 3), where they remain visible even after the feature progresses to the next scene or chapter. This convoluted, multi-frame approach detracts from the video content and clutters the viewing area.

Figure 3 of Exhibit B places the end products, as viewed by a user, side by side. Here it can be see identifying the product sought to be sold within the video content differs from placing the ad and icons in a different frame.

#### Applicant's Invention

Neither the '524 application nor the '398 patent teach, describe, or suggest a method of presenting purchasing information with a DVD having video content wherein the product or service is identified within the video content. As previously stated, the '524 application places the advertising material in a separate track located on the same, or different, DVD. The '398 patent identifies the product sought to be sold in separate frames, not within the video content. Neither reference contains the limitation of identifying the product within the video content and therefore a *prima facie* case of obviousness has not been established.<sup>4</sup>

Applicant has shown that the prior art does not teach or suggest all the claim limitations as required to establish a *prima facie* case of obviousness under 35 U.S.C. §103.<sup>5</sup> Applicant

<sup>4</sup> MPEP 2142

<sup>5</sup> *Id.*

provides claim charts, attached hereto as Exhibit A, to aid in showing the failure of the prior art to teach or suggest all the claim limitations of the independent claims of this application. Since the independent claims have been shown to be patentable over the prior art, the claims which depend there from are patentable as a matter of law. Applicant respectfully requests the withdrawal of the rejection on this ground.

Claim 1 has been amended for clarification only.

*Conclusion*

Entry of a Notice of Allowance is solicited. If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

By: 

Dated: September 7, 2005

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Attorneys for Applicant

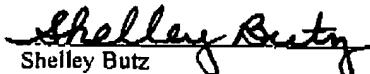
pc: John F. Baxter, Jr.

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CERTIFICATE OF FACSIMILE TRANSMISSION  
(37 C.F.R. 1.8(a))

I HEREBY CERTIFY that this Amendment B, including Introductory Comments, Amendments to the Claims, and Remarks, is being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 3627, Attn: Richard E. Chilcot, (571) 273-8300, on September 7, 2005.

Dated: September 7, 2005

  
Shelley Butz

**EXHIBIT A****Claim 1**

<b>Instant Invention</b>	<b>'524 Application Marshall</b>	<b>'398 Patent Collins-Rector</b>
A method of presenting purchasing information within a DVD having video content comprising the steps of:	Preamble	Preamble
identifying product <i>within the video content</i> sought to be sold,	<p>No</p> <p>[0010] – <i>after production</i>, generating an interactive catalog of featured products...</p> <p>[0012] The catalog is <i>organized by scenes</i> (not IN the scenes)</p> <p>[0027] Catalog may be recorded as <i>a separate track</i> on the DVD containing a movie <i>or on a separate disc.</i></p>	<p>No</p> <p>[col 2, 42-44] <i>Banner ads</i> are synchronized to video as it plays, not integrated within</p> <p>[col. 1, 45-50] advertisements <i>at predetermined times...</i> selectable buttons are maintained in a visible stack</p> <p>[col. 3, 15-16] html layout includes frames for video, ad, and ad toolbar (thumbnails)</p>
capturing at least one frame of the video content showing the product,	No	<p>No</p> <p>Products are shown in banner ads and thumbnails</p>
graphically modifying the frame to enhance the presence of the product within the video content,	No	<p>No</p> <p>Products are shown in banner ads and thumbnails</p>
creating a menu interface with the frame,	No	<p>No</p> <p>Information is obtained from clicking on thumbnails in visible stack</p>
creating a selectable menu button associated with the product,		
creating a second menu having purchasing information for the product,		<p>No</p> <p>Toolbar menu is always visible</p>
the second menu displayed responsive to the activation of the button.		<p>No</p> <p>Toolbar menu is always visible</p>

## Claim 6

Instant Invention	'524 Application Marshall	'398 Patent Collins-Rector
A method of presenting purchasing information with a feature on DVD comprising the steps of:	Preamble	Preamble
dividing a feature into a plurality of chapters;	No [0010] – <i>after production</i> , generating an interactive catalog of featured products...  [0012] The <i>catalog</i> (not the feature) is organized by <i>scenes</i> (not chapters)  [0027] Catalog may be recorded as <i>a separate track</i> on the DVD containing a movie <i>or on a separate disc</i> .	No The '398 patent does teach describe or discuss editing the video content into chapters.
generating a motion menu background of each individual chapter;	No [0028] user is presented with <i>thumbnails</i>	No [col 4, 5-7] Using html a page is created that contains <i>at least 3 frames</i> (video, ad, ad toolbar)
inserting at least one product information button over the motion menu background;	No [Fig. 4] Product selection buttons appear in a different frame.	No [4,57-59] thumbnails representing the product/ad are redrawn in another frame on the same page.
responsive to the activation of the at least one product information button linking to a product information menu having data on at least one product in the individual chapter played in the motion menu background.	No Product is not played in a motion picture background.	No Product is not played in a motion picture background.

## Claim 8

<b>Instant Invention</b>	<b>'524 Application Marshall</b>	<b>'398 Patent Collins-Rector</b>
A computer software application for authoring video menu structures on a DVD having video content, the software product comprising:	Preamble	Preamble
a product database module stored on a computer accessible medium, the product database module comprising at least a product identification data field and a time code data field;		
a menu generation module communicatively coupled to the product database module, the menu generation module generating a menu structure <b>within the video content</b> responsive to the presence of data fields in the product database module whereby product information contained within a <i>submenu</i> is <i>user-accessible substantially contemporaneous to a product's appearance in the video content.</i>	No  [0027] Catalog may be recorded as <i>a separate track</i> on the DVD containing a movie <i>or on a separate disc</i> .	No  [col 4, 5-7] Using html a page is created that contains <i>at least 3 frames</i> (video, ad, ad toolbar)

## Claim 25

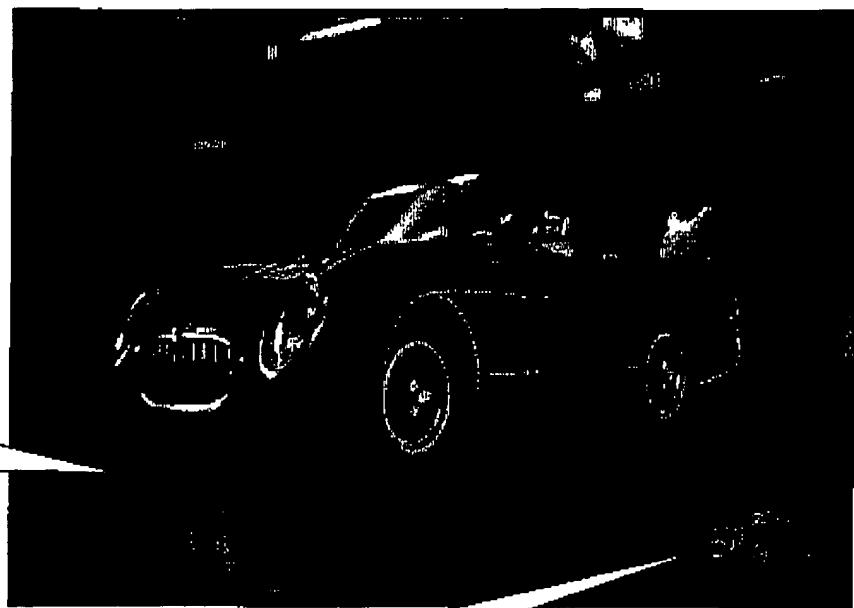
<b>Instant Invention</b>	<b>'524 Application Marshall</b>	<b>'398 Patent Collins-Rector</b>
A method of generating pre-production revenue for DVD video content comprising the steps of:	Preamble	Preamble
defining a product placement algorithm;		
contracting with at least one or more product distributors to insert the product <i>in the video content</i> according the product placement algorithm.	No [0027] Catalog may be recorded as <i>a separate track</i> on the DVD containing a movie <i>or on a separate disc.</i>	No [col 4, 5-7] Using html a page is created that contains <i>at least 3 frames</i> (video, ad, ad toolbar)

## Claim 30

<b>Instant Invention</b>	<b>'524 Application <i>Marshall</i></b>	<b>'398 Patent <i>Collins-Rector</i></b>
A method of distributing DVDs having variable advertising content comprising the steps of:	Preamble	Preamble
establishing an array of demographic data on an individual viewer;	No	
receiving a request for a video title from the viewer;	No	
automatically inserting advertising content targeted to the demographic data of the viewer into the video content;	No	No
recording the video title and targeted advertising content on a DVD;		No
and distributing the disc to the viewer.		No

## EXHIBIT B

Figure 1  
Applicant's Invention

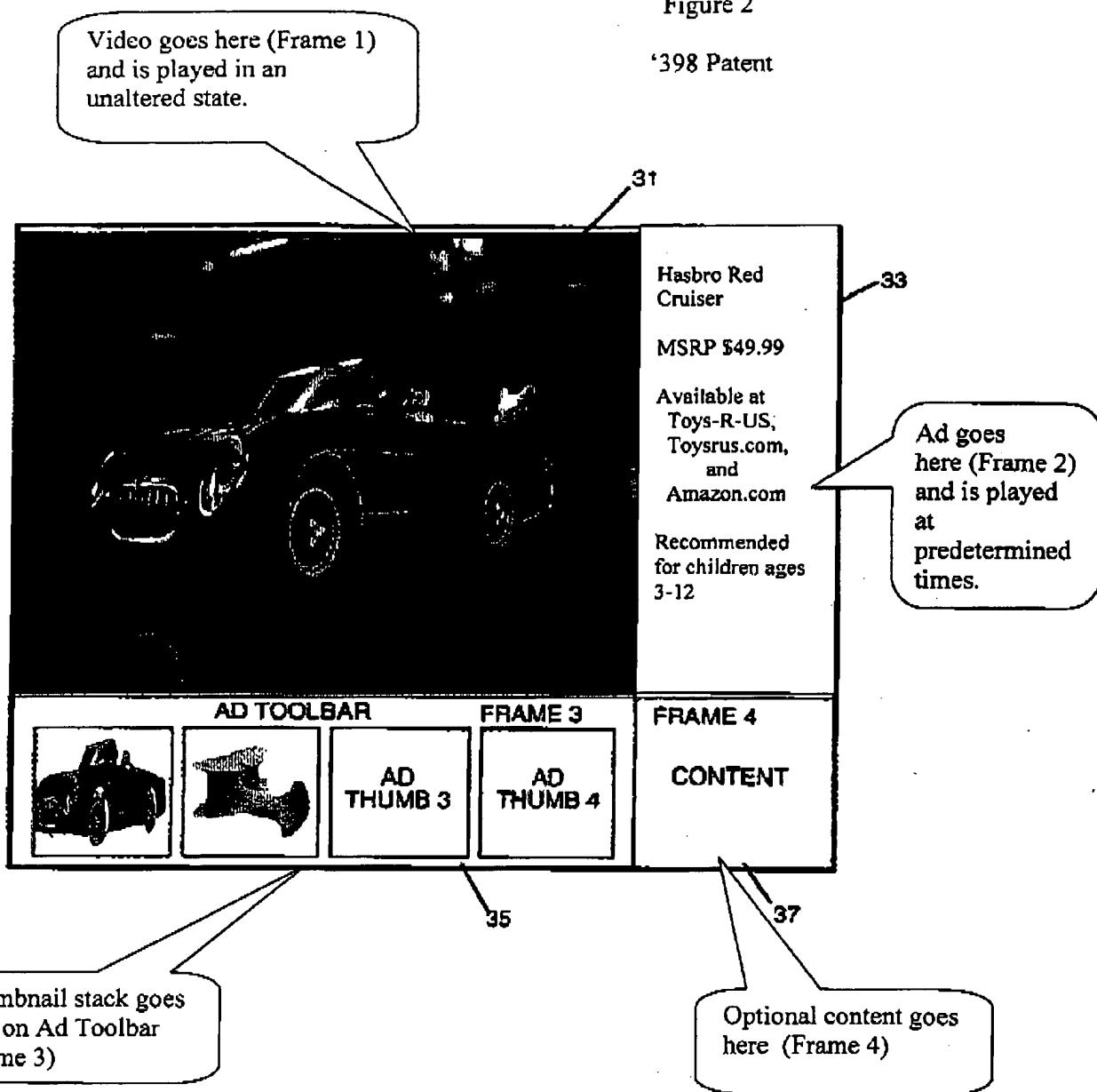


Entire feature comprises linked motion menus that time-out at end of respective clips and jump to next clip in sequence.

Objects form selectable buttons over motion menu. Unless selected, the motion menu will progress to the next clip in the feature presentation.

Figure 2

'398 Patent



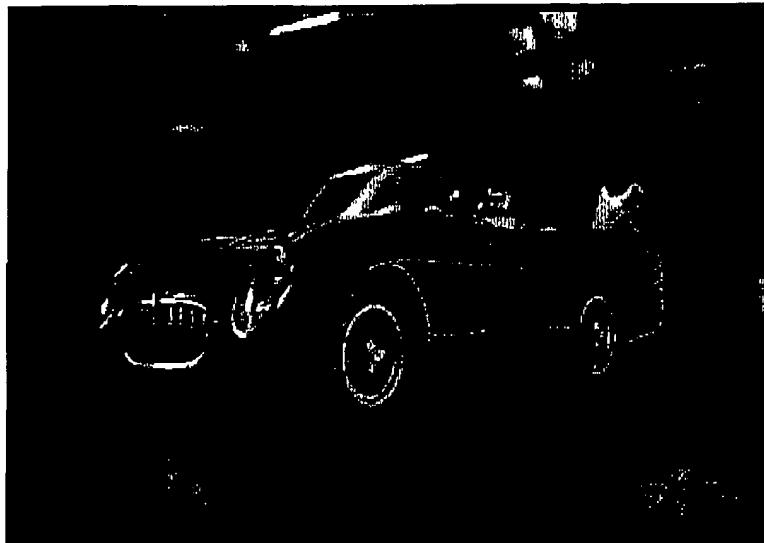


Figure 3

Applicant's Invention

'398 Patent

Hasbro Red Cruiser  
MSRP \$49.99  
Available at Toys-R-US, Toysrus.com, and Amazon.com  
Recommended for children ages 3-12

AD TOOLBAR	FRAME 3	FRAME 4

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